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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,012	02/12/2004	Regis Phillip Renaud	RENAUD.3DV1CP1	3348

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EXAMINER	
GRAVINI, STEPHEN MICHAEL	
ART UNIT	**PAPER NUMBER**
3749	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/778,012	RENAUD, REGIS PHILLIP	
	Examiner	Art Unit	
	Stephen Gravini	3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *06 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *2,4-7,9-12,15-17 and 19-25* is/are pending in the application.

4a) Of the above claim(s) *9-12,15-17 and 19-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *2,4-7 and 23-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 2, 4-7, and 23-25 drawn to a subcombination apparatus, classified in class 34, subclass 201.

II. Claims 10-12, 15-17, and 19-22 drawn to a subcombination method, classified in class 34, subclass 406.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand since the independently claimed method process feature of injecting high temperature steam and compressing refuse into a refuse block without being limited to a compaction chamber are independent and distinct from the independently claimed apparatus inventions and can be considered to be practiced by hand because the independently claimed apparatus is not limited to high pressure steam and is limited to a press configured to compress refuse in a compact chamber. These feature are considered independent and distinct such that the independently claimed method must be practiced with the same structure and steps as the independently claimed apparatus. Examples of independent and distinct method

and apparatus claims would be overcome by reciting "injecting high temperature steam..." and "means for injecting high temperature steam..." or "extracting the steam" and "means for extracting the steam." These recitations can overcome the independent and distinct restriction requirement and would make the inventions co-extensive, as discussed in the most recent interview.

Applicant's election with traverse of group II claims 4-7 (now group I claims 2, 4-7, and 23-25 in this application) in the reply filed on March 6, 2006 is acknowledged. The traversal is on the grounds that amended claim 4 recites a compaction station for treating and compacting refuse while amended claim 10 recites a method of treating and compacting refuse *within a compaction station* (emphasis added). This is not found persuasive because the amended claims contain independent and distinct features such as an independent claim recitation of high pressure steam in one embodiment but not another embodiment and *within* a compaction chamber in the other embodiment but not a first embodiment. This represents a serious burden upon the Office since both search areas are separately classified which necessitates searching among hundreds of thousands of prior art references among the many databases needed to provide a quality examination of the claimed invention.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

Applicant has submitted numerous prior art references with only minimal discussion of just a few of those references. It is urged that the applicant cite the most relevant references and highlight those portions as each most pertains to the claimed

invention. It appears that none of the references cited by the applicant are pertinent to the elected claimed invention such that any teaching of the claimed invention is buried among more than 50 prior art references. Please see MPEP 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Camacho (US 5,634,414). Camacho is considered to disclose the claimed invention comprising:

a compaction chamber **20**;

at least one steam port **24** configured to inject steam into the compaction chamber;

at least one steam extractor configured to remove steam from the compaction chamber as discussed in column 5 line 39; and

at least one press **32** configured to compress refuse in the compaction chamber. Camacho is considered to also disclose a platform for holding the refuse as shown in figures 1 and 3, an opening, and the platform is configured to rotate such that the refuse placed on the platform will engage a wiper that holds the refuse until the opening in the platform slides underneath the refuse, permitting the refuse to fall into a holding bin also

show in figures 1 and 3, and a scanner that is configured to scan the refuse treated by the compaction station as discussed in column 3 line 54.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho in view of Smith et al. (US 3,550,791). Camacho is considered to disclose the claimed invention, as rejected above, except for the claimed rotatable platform. Smith, another apparatus for treating and compacting refuse, is considered to disclose a rotatable platform at column 2 line 50 through column 3 line 22. It would have been obvious to one skilled in the art to combine the teachings of Camacho with the rotatable platform, considered disclosed in Smith, for the purpose of conveying and delivering material throughout the apparatus.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho in view of Wood (US 3,747,516). Camacho is considered to disclose the claimed invention, as rejected above, except for the claimed hydraulic ram. Wood, another apparatus for treating and compacting refuse, is considered to disclose a hydraulic ram at column 4 lines 26 through 30. It would have been obvious to one skilled in the art to combine the teachings of Camacho with the hydraulic ram, considered disclosed in Wood for the purpose of bailing material in a single stroke.

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho in view of Carter et al. (US 5,280,757). Camacho is considered to disclose the claimed invention, as rejected above, except for the claimed boiler and condenser. Carter, another apparatus for treating and compacting refuse, is considered to disclose a boiler and condenser at column 3 line 1 through column 4 line 48. It would have been obvious to one skilled in the art to combine the teachings of Camacho with the boiler and condenser considered disclosed in Carter, for the purpose of allowing steam formation and steam condensation in a refuse treatment apparatus.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-32 of U.S. Patent No. 6,471,448 in view of Camacho. Applicant's patented invention is considered to disclose all of the elements currently claimed except for the claimed compaction means. Camacho, another refuse treatment apparatus, is considered to disclose compaction means as rejected above. It would have been obvious to one skilled in the art to combine the patented teachings of applicant's invention with compaction means disclosed in Camacho for the purpose of compressing refuse.

Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-32 of U.S. Patent No. 6,471,448 in view of Camacho in further view of Smith. Applicant's patented invention is considered to disclose all of the elements currently claimed, as obviated by Camacho above, except for the claimed rotatable platform. Smith, another apparatus for treating and compacting refuse, is considered to disclose a rotatable platform at column 2 line 50 through column 3 line 22. It would have been obvious to one skilled in the art to combine the teachings of applicant's patented invention in view of Camacho with the

rotatable platform, considered disclosed in Smith, for the purpose of conveying and delivering material throughout the apparatus.

Claims 23-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-32 of U.S. Patent No. 6,471,448 in view of Camacho in further view of Carter. Applicant's patented invention is considered to disclose all of the elements currently claimed, as obviated by Camacho above, except for the claimed boiler and condenser. Carter, another apparatus for treating and compacting refuse, is considered to disclose a boiler and condenser at column 3 line 1 through column 4 line 48. It would have been obvious to one skilled in the art to combine the teachings of applicant's patented invention in view of Camacho with the boiler and condenser considered disclosed in Carter, for the purpose of allowing steam formation and steam condensation in a refuse treatment apparatus.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 571 272 4875. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMG
March 22, 2006

Stephen Gravini